

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/667,779
ATTORNEY DOCKET NO. Q60742

REMARKS

Applicants thank the Examiner for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, European Patent Application No. 99440259.2 dated September 24, 1999, has been made of record in the file.

Applicants request the Examiner to consider the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on September 22, 2000, and return an initialed PTO-1449 form.

Applicants herein cancel the Abstract of the Disclosure and submit a new Abstract of the Disclosure. The new Abstract does not add any new matter. Entry of the new Abstract is requested.

Claims 1-12 have been examined on their merits.

The amendments to claims 2 and 4-9 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 2 and 4-9 were not made for reasons of patentability.

Claims 1-12 are all the claims presently pending in the application.

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1. Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Neilsen (U.S. Patent No. 5,870,548). Applicants traverse the rejection of claims 1-12 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

With respect to claim 1, Neilsen fails to teach or suggest routing a modification message that modifies a body of a sent e-mail to a server where the sent-email is stored and modifying the body of the sent e-mail if a plurality of addressees have not accessed the e-mail body. While the Examiner cites col. 6, lines 4-67, col. 7, lines 1-67, col. 8, lines 1-59, Figure 4 and Figure 5 of Neilsen as allegedly disclosing the recitations of claim 1, the cited passages and Figures disclose the modification of e-mail addresses, not the body of a sent e-mail message. For example, step 415 in Figure 4 discloses that if a new email address for a particular recipient is found, a new e-mail message sent to the recipient using the content of the original e-mail message. *See* col. 6,

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lines 56-59 of Neilsen. No modification of the content of the original e-mail message, sent to a plurality of addressees, is taught or suggested. In Figure 5, step 509 replaces e-mail addresses in an address book. Again, no modification of the content of the original e-mail message is taught or suggested.

Based on the foregoing reasons, Applicants submit that Neilsen fails to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claim 2 is allowable as well, at least by virtue of its dependency from claim 1. Applicants respectfully request that the Examiner withdraw the § 102(e) rejection of claims 1 and 2.

With respect to independent claim 3, Neilsen fails to teach or suggest a server having means that sends out an access code for a body of a stored e-mail message, means for receiving a modification message that modifies a body of a sent e-mail stored on the server and means for modifying the body of the sent e-mail if at least one of a plurality of addressees has not accessed the e-mail body stored on the server. Neilsen discloses that the e-mail recipient's terminal receives the modification message and the recipient's e-mail program modifies the message. There is no disclosure in Neilsen that the modification of the e-mail body is executed as long as the plurality of addressees has not accessed the e-mail body stored on the server. In fact, Neilsen discloses allowing the e-mail recipient to view the number of changes to the e-mail body, regardless of the number of addressees for that particular e-mail body. *See, e.g.*, col. 16, lines 26-60 of Neilsen.

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Based on the foregoing reasons, Applicants submit that Neilsen fails to disclose all of the claimed elements as arranged in claim 3. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 3. Thus, Applicants submit that claim 3 is allowable, and further submit that claims 4-10 are allowable as well, at least by virtue of their dependency from claim 3. Applicants respectfully request that the Examiner withdraw the § 102(e) rejection of claims 3-10.

With respect to independent claim 11, Neilsen fails to teach or suggest a computer program product that composes a modification message for modifying the body of a stored e-mail message addressed to a plurality of addressees as long as the plurality of addressees has not accessed the stored e-mail body. Similar to claim 3, there is no disclosure in Neilsen that the modification of the e-mail body is executed as long as the plurality of addressees has not accessed the e-mail body stored on the server.

Based on the foregoing reasons, Applicants submit that Neilsen fails to disclose all of the claimed elements as arranged in claim 11. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 11. Thus, Applicants submit that claim 11 is allowable, and further submit that claim 12 is allowable as well, at least by virtue of their dependency from claim 11. Applicants respectfully request that the Examiner withdraw the § 102(e) rejection of claims 11 and 12.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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